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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,598	11/09/1999	ANDREAS LENNIGER	GR-97-P-1593	6870

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EXAMINER

GRAYBILL, DAVID E

ART UNIT PAPER NUMBER

2814

DATE MAILED: 12/04/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/436,598

Applicant(s)

LENNIGER ET AL.

Examiner

David E Graybill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 and 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by applicant's admitted prior art.

At page 1, line 10 to page 2, line 13; and page 6, line 11 to page 7, line 14, applicant admits as conventional a product comprising a substrate 4 disposed in a plastic housing 2 defining a housing base of the housing, the substrate containing a ceramic plate 5 having a top side and a bottom side with a top metallization layer 6 disposed on the top side and a bottom metallization layer 7 disposed on the bottom side, the top metallization layer facing an interior of the housing being patterned in order to form interconnects and equipped for and receiving semiconductor components 10; connecting elements 8 interconnecting the components; and terminal elements 11 for providing external terminals in housing element openings, wherein the elements run approximately parallel to the housing base in the interior of the housing, the housing includes a frame 9 and a cover, the elements are disposed in the frame, and

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the substrate is covered with a potting compound (illustrated in FIG 1).

Although applicant does not appear to explicitly admit as prior art the process limitation "terminals press-fitted into housing element openings," the product of applicant's admitted prior art inherently possesses the characteristics imparted by the limitation.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35

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U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art as applied to claims 1 and 3-6, and further in combination with Leukel (FR2535898).

Although applicant admits as prior art a product wherein the housing has an inner side, applicant does not appear to explicitly admit as prior art a product wherein the elements have lugs which bear on the inner side for fixing the elements in position, and the compound is formed of a soft potting layer and a hard potting layer disposed on the soft layer. Nonetheless, at page 6, lines 11-21, Leukel teaches a product wherein elements 10, 12 have lugs which bear on the inner side of housing 16 for fixing the elements in position, and the compound is formed of a soft potting layer 15 and a hard potting layer 16 disposed on the soft layer. Moreover, it would have been obvious to combine the product of Leukel with the product of applicant's admitted prior art because it would increase package reliability.

Applicant's remarks filed 10-15-01 have been fully considered and are addressed infra.

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Applicant contends that the applied prior art does not teach the process limitation, "terminals press-fitted into housing element openings." This contention is respectfully deemed to be unpersuasive because the applied prior art is not relied on in the rejection for this teaching. To further clarify, it is noted that rejection under 35 U.S.C. 102 and/or 35 U.S.C. 103 is indicated where prior art discloses a product that appears to be either identical with or only slightly different from the product claimed in a product by process claim. Further, applicant can be required, to prove that the prior art product does not necessarily or inherently possess characteristics of the claimed product. Whether the rejection is based on inherency under 35 U.S.C. 102, on prima facie obviousness under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same. When, as here, there is reason to believe that the functional limitation asserted to be critical for establishing novelty in the claimed subject matter is an inherent characteristic of the prior art, the Office possesses authority to require applicant to prove that subject matter shown to be in the prior art does not possess the characteristic relied on. See *In re Fitzgerald, Sanders, and Bagheri*, 205 USPQ 594 (CCPA 1980).

Applicant also alleges that the scope of the instant invention is limited to a process "without encapsulation of the terminal elements by injection molding." This allegation is respectfully traversed because the product claims are not so limited, and the prior art is not applied to the rejection for this teaching. To further clarify, it is noted that rejection under 35 U.S.C. 102 and/or 35 U.S.C. 103 is indicated where prior art discloses a product that appears to be either identical with or only slightly different from the product claimed in a product by process claim. Further, applicant can be required, to prove that the prior art product does not necessarily or inherently possess characteristics of the claimed product. Whether the rejection is based on inherency under 35 U.S.C. 102, on prima facie obviousness under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same. When, as here, there is reason to believe that the functional limitation asserted to be critical for establishing novelty in the claimed subject matter is an inherent characteristic of the prior art, the Office possesses authority to require applicant to prove that subject matter shown to be in the prior art does not possess the characteristic relied on. See *In re Fitzgerald, Sanders, and Bagheri*, 205 USPQ 594 (CCPA 1980).

This is an RCE of applicant's earlier Application No. 09/436,598. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any telephone inquiry of a general nature or relating to the status (MPEP 203.08) of this application or proceeding should be directed to the group receptionist whose telephone number is 703-308-1782.

Any telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (703) 308-2947. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.

The fax phone number for group 2800 is 703/305-3431.

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A handwritten signature in black ink, appearing to read 'D.E. Graybill', is positioned above the printed name.

David E. Graybill
Primary Examiner
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D.G.
2-Dec-01